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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,167	10/31/2003	Nicholas A. D'Agosto III	02158.0410.NPUS00	9089
47669	7590	07/28/2005	EXAMINER	
KELLEY DRYE & WARREN LLP			ESCALANTE, OVIDIO	
101 PARK AVENUE			ART UNIT	
NEW YORK, NY 10178			PAPER NUMBER	
			2645	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,167

Applicant(s)

D'AGOSTO ET AL.

Examiner

Ovidio Escalante

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8-6-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement submitted on August 6, 2004 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

Claim Objections

3. Claims 1-8 are objected to because of the following informalities: The preamble of claim 1, claims a system and method, however, there is no system limitations in the claim since the claims state "the method comprising the steps of". Therefore, for claims 1-8 "system" should be removed from the preamble or amended to overcome this objection. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,2 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowater et al. US Patent 6,278,772.

Art Unit: 2645

Regarding claim 1, Bowater teaches a system and method for producing a telephone conference record, (abstract; col. 5, lines 21-37), the method comprising the steps of:

detecting when the user has called a recorder port, (col. 7, lines 5-26);

opening a call record and recording the telephone call when the user is connected to a recorder port, (col. 7, lines 5-26);

detecting when the user's telephone line is disconnected, (col. 5, lines 21-37); and

stop recording and close the call record if the user's telephone line is disconnected, (col. 5, lines 21-37).

Regarding claim 2, Bowater, as applied to claim 1, teaches capturing the calling line identification associated with the user if the user has called a recorder port, (col. 5, lines 21-37).

Regarding claim 5, Bowater, as applied to claim 1, teaches wherein the recorder port is associated with a PBX, (col. 5, lines 21-37; figs. 1 and 2).

Regarding claim 6, Bowater, as applied to claim 5, teaches wherein the user is associated with the PBX, (col. 5, lines 21-37; figs. 1 and 2).

Regarding claim 7, Bowater, as applied to claim 5, teaches claim 5, wherein the recorder port is one of a plurality of recorder ports associated with the PBX, and wherein the call to a recorder port may be connected with any of the plurality of recorder ports not recording at that time, (figs. 1 and 2; col. 5, lines 21-37; col. 3, lines 44-55).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2645

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowater in view of Bress et al. US Patent 5,570,420.

Regarding claims 3 and 4, Bowater, as applied to claim 1, does not specifically teach wherein the user calls another party prior or after calling the recorder port.

In the same field of endeavor, Bress teaches wherein the user calls another party prior to calling the recorder port and wherein the user calls another party after calling the recorder port, (col. 4, line 53-col. 5, line 15).

Art Unit: 2645

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Bowater by adding a caller before or after connecting to the voice recorder as taught by Bress so that the user can decide to add in a third party (e.g. a supervisor) who at that point can decide that the call should be recorded or so that the user can add a third party during the call recording process if something important comes up that needs supervisory or expert help.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowater in view of Edwards US Patent 6,744,877.

Regarding claim 8, Bowater, as applied to claim 7, does not specifically teach wherein the user is associated with a hunt group.

In the same field of endeavor, Edwards teaches wherein a user is associated with a hunt group that is configured to only a distinct subset of the plurality of recorder ports, (col. 2, lines 17-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bowater by using hunt groups as taught by Edwards so that the system resources can be balanced amount all recorders. This will prevent one recorder from handling most of the recordings.

Conclusion

11. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Art Unit: 2645

Or:

(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
Examiner
Group 2645
July 15, 2005

O.E./oe